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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/799,135   | 03/11/2004  | Joseph S. Cavallo    | 10559-707002        | 8491             |
| 20985  | 7590        | 11/03/2006           | EXAMINER            |                  |
| FISH & RICHARDSON, PC<br>P.O. BOX 1022<br>MINNEAPOLIS, MN 55440-1022 |             |                      | PATEL, HETUL B      |                  |
|  |             | ART UNIT             | PAPER NUMBER        | 2186             |

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                         |                  |
|------------------------------|-------------------------|------------------|
| <b>Office Action Summary</b> | Application No.         | Applicant(s)     |
|                              | 10/799,135              | CAVALLO ET AL.   |
|                              | Examiner<br>Hetal Patel | Art Unit<br>2186 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 September 2006.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-29 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This office action is in response to the communication filed on 09/28/2006. Claims 1, 3, 5, 12, 14, 16, 22, 24 and 26 are amended. Claims 1-29 are pending in this application.
2. Applicant's arguments filed on 09/28/2006 have been considered but are moot in view of the new ground(s) of rejection.

***Terminal Disclaimer***

3. The terminal disclaimer filed on 09/28/2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,779,053 has been reviewed and is accepted. The terminal disclaimer has been recorded. As a result of this terminal disclaimer, the double patenting rejection made in previous office action is withdrawn.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-29 are rejected under 35 U.S.C. 101 because the language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical

application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 USC 101.

There is no tangible (real world) result found due to the mere "determining" steps in combination in claim 1 and, equivalently, the mere "determining" functionality of the machine operations as would be controlled by (i) the instructions in claim 12 and (ii) functions/processing steps in claim 22. In addition, it appears that the second step/operation/function only occurs upon satisfying the previous "if it does" condition. Upon failure to satisfy that condition, these claims include only the first recited step (claim 1) or operation (claim 12), or function (claim 22) which, of course, by itself, also fails to cause the respective claim to provide a tangible result. The same arguments also applies to the dependent claims 2-8, 13-18 and 23-29. In short, none of claims 1-8, 12-18 and 22-29 produce a useful, concrete and tangible result. And furthermore, determining, defining, setting, indicating and tracking steps, in or of itself, is not a useful result. To render a tangible result, the steps of determining must be followed by at least one other step producing a tangible result. For example, a step of storing the result of determination, or displaying the result of determination or using the result of determination in such fashion might produce a tangible result.

Furthermore, even though dependent claims 9 and 19 produce a concrete and tangible result by having a step/operation of storing the tracking address, they do not satisfy the usefulness requirement. In other words, claims 9 and 19 satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of

35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a “useful, concrete and tangible” result to have a practical application.

Claims 10-12 and 20-21 are also rejected as they depend upon the rejected base claims 9 and 19, respectively.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hetul Patel whose telephone number is 571-272-4184. The examiner can normally be reached on M-F 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Kim can be reached on 571-272-4182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**PIERRE BATAILLE**  
**PRIMARY EXAMINER**  
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